

REMARKS

In order to advance prosecution of the present application, claim 1 has been amended to include means for folding said substantially flat elongated body for easy transportation. New claim 9 has been added to recite an apparatus as recited by claim 1, wherein said means for folding comprises at least one hinge spanning the width of the substantially flat elongated body. The amendment to claim 1, together with new claim 9, is clearly supported by the original specification, particularly at page 5, lines 25-28; page 8, lines 3-6; and Fig. 3.

The electrician's measuring apparatus required by applicant's claims 1, 2, 5, and 9, as amended, includes a substantially flat elongated body having a first end, a second end, a front side, a back side, and a longitudinal axis. The electrician's measuring apparatus disclosed by present claims 1, 2, 5, and 9 further comprises a plurality of slots disposed on the elongated body at a plurality of locations. More specifically, the electrician's measuring apparatus includes a first horizontal slot for marking the placement of an outlet box, a second horizontal slot for marking the placement of a counter height outlet, and a third horizontal slot for marking the placement of a standard wall switch. Therefore, each slot of applicant's claimed invention determines placement of outlet boxes, counter height outlets and standard wall switches, respectively, in accordance with selected standards or codes so that a single outlet box, counter height outlet, or standard wall switch may be located at different heights that are inherently unrelated. Present claims 1, 2, 5, and 9 further provide a set of indicia on each edge of the front side of the elongated body for indicating the distance from the elongated body's first end, and a level for leveling the length of the claimed apparatus vertically. Present claims 1, 2, 5, and 9 further provide means for folding said substantially flat elongated body for easy transportation.

wherein said means comprises at least one hinge spanning the width of the substantially flat elongated body. Advantageously, the electrician's measuring apparatus called for by applicant's present claims 1, 2, 5, and 9 readily guides the electrician in accurately and levelly positioning outlet boxes, counter height outlets and standard wall switches at precise locations above regular and irregular floors or other surfaces (such as counters) in compliance with applicable requirements set forth by relevant construction standards and codes.

The invention, as recited by applicant's present claim 1, 2 5, and 9 provides an integrated electrician's measurement apparatus that can be used to vertically mount outlet boxes, counter height outlets, and standard wall switches at different heights that are inherently unrelated and correspond to heights specified by industry standards or building codes. In addition the integrated electrician's measurement apparatus, as recited by applicant's present claims 1, 2, 5, and 9 can be used to horizontally mount outlet boxes, counter height outlets, and standard wall switches, and especially outlets in horizontal proximity to one another in conformance with code regulations and industry standards. When vertically mounting outlets using applicant's apparatus, as defined by present claims 1, 2, 5, and 9, an electrician can use a first slot located on the electrician's measurement apparatus to mount an outlet box according to industry standards. Subsequently, the electrician can use a second slot located on the identical electrician's measurement apparatus to vertically mount a counter height outlet conforming to an industry standard for counter height outlets. Lastly, the electrician can use a third slot located on the same electrician's measurement apparatus to vertically mount a standard wall switch conforming an industry standard for standard wall switches. Moreover, applicant's claimed electrician's measurement apparatus has an elongated body that represents the code specified horizontal

distance required between outlets, so that the electrician can manually rotate the device horizontally and readily mark the horizontal distance between outlets as required by industry standards.

The electrician's measurement apparatus recited by claims 1, 2, 5, and 9 provides an accurate mechanism that precisely locates an electrical junction box (the size and shape of which may vary considerably) at a selected distance from the floor or counter top, thereby meeting applicable code requirements and maintaining the box "in level" without necessity of additional measurement hardware when vertically mounting the box. While at the same time, the electrician's measurement apparatus required by claims 1, 2, 5, and 9 provides an accurate mechanism that readily locates the code required horizontal distance between outlets in a highly accurate, time efficient manner, thereby economically and reliably installing the junction boxes in accordance with applicable code requirements. Further, the electrician's measurement apparatus required by claims 1, 2, 5, and 9 provides an apparatus that is easy to transport because it comprises means for folding the substantially flat elongated body.

Claim Rejections – 35 USC § 103

The Examiner has rejected claims 1 and 5 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,072,523 to Bennett in view of U.S. Patent 5,222,303 to Jardine, U.S. Patent 5,598,638 to Plesh, and U.S. Patent 5,361,509 to Wheeler, Sr. et al. (hereinafter Wheeler).

Bennett discloses a tool for use in mounting electrical boxes to wall studs. An upright member includes a plurality of slots along its length for receiving an electrical box. The slot has a width dimension to hold the box at a predetermined depth for mounting on a stud. The position

of the slot along the length of the upright determines the height at which a box will be mounted. Different slots are provided for various box mounting height and depth requirements

The Examiner has stated that Bennett discloses an apparatus comprising an elongated body with first and second ends and front and back sides and a longitudinal axis. The Examiner has indicated that Bennett further discloses a first horizontal slot, e.g., at 32 in figure 2, disposed on the body at a first location and arranged perpendicularly to the axis for determining placement of an outlet box in accordance with a selected standard or code. The Examiner has indicated that Bennett further discloses a second horizontal slot disposed on the body at a second location and arranged perpendicularly to the axis for determining placement of an outlet box in accordance with a selected standard or code. The Examiner has indicated that Bennett further discloses a third horizontal slot disposed on the body at a third location and arranged perpendicularly to the axis for determining placement of standard wall switches in accordance with a selected standard or code (see figure 6). The Examiner has indicated that Bennett further teaches that the slots are located at different locations along the body so that electrical boxes and switches can be placed at proper locations, i.e., standard locations.

Regarding the Bennett disclosure, it is respectfully submitted that in view of the amendments to claims 1 and 5, these claims patentably define over Bennett in view of Jardine, Plesh, and Wheeler. First, Bennett, as the primary reference, does not disclose or suggest a substantially flat elongated member, together with means for folding the substantially flat elongated body for easy transportation. Bennett requires a back wall 12, a first sidewall 14, and a second sidewall 16, thereby forming a member that is U-shaped, when viewed from its top, and is therefore not substantially flat. The Examiner has taken the position that the second

sidewall 16 of Bennett meets the present limitation of claim 1 having a substantially flat elongated member. Applicant respectfully submits that even in light of the Examiner's position, Bennett still does not disclose means for folding the substantially flat elongated body for easy transportation, as required by present claim 1. **Inasmuch as the device disclosed by Bennett is U-shaped, it is not possible to fold it because it is not substantially flat.**

Further, each of the first and second sidewalls of Bennett, respectively, include slots of varying depth to accommodate various sized wallboard material depths. Namely, as recited at col. 2, lines 61-65 of Bennett: "In order to use the tool of the present invention, a box 44 is inserted into an appropriate slot (depending on the thickness of wallboard to be used) with the box sidewall 45 adjoining the inside of the respective tool sidewall, such as sidewall 14 as illustrated in FIG. 5." Namely, the slots disclosed by Bennett are located on the sidewalls and not on the back wall. By way of comparison, the invention called for by present claims 1 and 5 requires a first horizontal slot, a second horizontal slot, and a third horizontal slot, respectively, each of the slots being positioned effectively on the "back wall" of the elongated member, because there is only one wall of the elongated member, said wall being substantially flat. Because the slots of the present invention, as called for by present claims 1 and 5, are located on the "back wall" of the elongated member, a pencil or other writing utensil is readily utilized to mark the location of outlet boxes, counter height outlets, and standard wall switches, once the elongated member has been properly leveled. By way of comparison, the slots disclosed by the Bennett device do not line up against the wall board. As a result, marking the location of outlet boxes, counter height outlets and standard wall switches with a pencil using the Bennett device is not so readily accomplished.

Significantly, the apparatus disclosed by Bennett could not be modified to be substantially flat and include slots on the back wall, and be able to be folded because then Bennett would not operate as intended. *See* MPEP 2103.01(V), which states that the proposed modification cannot render the prior art unsatisfactory for its intended purpose. That is to say, the sidewalls taught by Bennett are critical to its disclosure and its mode of operation. In order to modify the Bennett device so that it is substantially flat, and able to be folded, its sidewalls would have to be removed, thereby rendering the device unsatisfactory for its intended purpose – that purpose being to capture and hold an electrical box in a slot in the sidewall, *so that it is held at a predetermined distance from a stud* while it is mounted to the stud.

Further, in its preferred embodiment, the Bennett apparatus teaches only two sets of slots; not three. By way of comparison, present claims 1 and 5 require three horizontal slots – namely, a first horizontal slot for marking the placement of an outlet box, a second horizontal slot for marking the placement of a counter height outlet, and a third horizontal slot for marking the placement of a standard wall switch. In an alternative embodiment, shown at Fig. 6, the Bennett apparatus includes four sets of slots; however, in operation and by its specific design, only two of the four slots of Bennett are used at any given installation, for installing only two types of electrical boxes. The decision of which of the two slots to use depends on the thickness of the wall board. *See* Bennett at col. 3, lines 14-34.

In summary, as the primary reference, Bennett fails to disclose: (i) a substantially flat elongated body; (ii) the horizontal slots being located on the back wall of the body; (iii) a first horizontal slot for marking the placement of an outlet box, a second horizontal slot for marking the placement of a counter height outlet, and a third horizontal slot for marking the placement of

a standard wall switch; and (iv) means for folding the substantially flat elongated body for easy transportation. Furthermore, the apparatus disclosed by Bennett could not be modified to include these features because it would render the apparatus unsatisfactory for its intended purpose. *See* MPEP 2103.01(V).

The Examiner has acknowledged that Bennett does not disclose an apparatus having a length of 4-6 feet; a width of 2-4 inches; a set of indicia located along each edge of the front side of the body for indicating the distance of the slots from the first end; and a level for vertically leveling the apparatus. However, the Examiner has pointed to Jardine for teaching a measuring apparatus for locating the position of an electrical box. The Examiner has indicated that the apparatus taught by Jardine discloses a level (26) thereon for properly positioning the apparatus vertically to allow accurate positioning of the box, and indicia along an edge of the front side of the body for indicating distance from a first end.

Further, the Examiner has stated that Plesh discloses an apparatus for marking the location of electrical boxes on a wall; that the apparatus has an elongated body for determining placement of a box above a floor in accordance with desired standards such that a single box may be located at different heights that are unrelated to each other; and that the length of the body is between 4 to about 6 feet and the width of a first end of the body is 2-4 inches in order to place a box vertically along the length of a wall or stud (see figure 1; and column 4, lines 55-60).

Further, the Examiner has stated that Wheeler discloses that it is known to provide an outlet box at a counter-high level (see column 6, lines 41-44).

Applicant submits that the proposed combination of Bennett in view of Jardine, Plesh, and Wheeler does not disclose or suggest each and every element as required by present claims 1

and 5, as amended. Namely, Plesh discloses a device that is used similar to a tape measure, where one places the stick 10 up against a stud, holds the stick 10 tightly against the stud, places an electrical box to be mounted next to stick 10, and nailing the box into the stud. Plesh does not disclose or suggest horizontal slots located on the body of the device. By way of comparison, the apparatus disclosed by present claims 1 and 5 call for a first, second, and third horizontal slot on the substantially flat elongated body, wherein a user marks the location of an outlet box, counter height outlet, or a standard wall switch, respectively, by using a writing utensil to mark a line on the wall showing where to mount the electrical box. When using the apparatus disclosed by present claims 1 and 5, a user has full control of both of his hands to first mark the location of the housing, then remove the elongated body from against the wall, then use both hands to position the electrical box at the marking, and then he is able to easily mount the electrical box in the wall. In view of these remarks, and the remarks filed April 1, 2005 and April 13, 2006, applicant respectfully submits that the combination of Bennett in view of Jardine, Plesh, and Wheeler does not disclose or suggest each element of present claims 1 and 5.

Accordingly, reconsideration of the rejection of claims 1 and 5 under 35 USC 103(a) as being unpatentable over U.S. Patent 5,072,523 to Bennett in view of U.S. Patent 5,222,303 to Jardine, U.S. Patent 5,598,638 to Plesh, and U.S. Patent 5,361,509 to Wheeler is respectfully requested.

Claim 2 was rejected under 35 USC 103(a) as being unpatentable over Bennett, Jardine, Plesh, and Wheeler, as applied to claims 1 and 5 above, and further in view of U.S. Patent 2,713,203 to Gottlieb.

Claim 2 depends from currently amended claim 1, which is submitted to be patentable for the reasons set forth hereinabove. Inasmuch as claim 2 contains all the limitations of independent amended claim 1, it is submitted that this dependent claim is also patentable over Bennett, Jardine, Plesh, and Wheeler, as applied to claims 1 and 5 above, and further in view of Gottlieb.

Gottlieb discloses a house framing device intended and adapted for use by individual house builders and others who may not be skilled in building. (Gottlieb, column 1, lines 15 – 19). The house framing device taught by Gottlieb comprises an elongated flat template of substantially the width of the framing member to be cut, substantially conforming to a width of 8 inch and 10 inch finished framing joists. (Gottlieb, column 6, lines 49 – 53, and column 3, lines 7 – 8, respectively). Gottlieb teaches that the overall length of the device is to be equal to the length of the longest framing member, maximum in length of about 14 feet or 16 feet (standard lengths of material). (Gottlieb, column 2, lines 65 – 67, and column 3, lines 2 – 3, respectively). At these taught widths and lengths, Gottlieb further teaches that the device comprises slot-like openings (5) and (6) that can be formed through the portions (2) and (3) (which join together to make-up the measuring strip) at any desired distances from the base measuring end of the measuring strip (1). (Gottlieb, column 3, lines 61 – 65).

The measuring strip taught by Gottlieb is merely utilized in framing, and does not have a first horizontal slot for marking the placement of an outlet box, a second horizontal slot for marking the placement of a counter height outlet, and a third horizontal slot for marking the placement of a standard wall switch, each slot located at standard or code related guidelines, and cannot be utilized for placing outlet boxes, counter height outlets and standard wall switches but

is merely used for framing. The slot-like openings in Gottlieb are utilized to mark different lengths of material of the particular stock dimension so that the different materials can be cut. (Gottlieb, column 3, lines 65 – 67). The Examiner has stated that the measuring apparatus of Gottlieb is for marking and locating the position of a line conforming to building laws and other requirements [i.e., codes and standards] for marking a straight line; and that the apparatus may have text for indicating instructions and guidelines to allow an inexperienced individual using the apparatus to conform to building laws and other requirements [i.e., codes and standards] (see column 3, line 68 to column 4, line 10).

However, applicant points out that the slot-like openings (5) and (6) can be formed through the measuring strip at any desired distances from the base measuring end, these desired distances being integrally dependent on the length of each framing member and where each piece is to be installed relative to one another in erecting the frame of a building. (Gottlieb, column 3, lines 63 – 67, and column 4, lines 1 – 5, respectively). The slot-like openings in Gottlieb are not pre-selected and pre-cut based on regulatory specifications specifically tailored towards the placement of outlets, switches, and electrical boxes. Rather, the slots in Gottlieb are determined and cut by an individual “while an individual is cutting and erecting a particular framing portion.” (Gottlieb, column 2, lines 54 – 58).

Gottlieb fails to teach an electrician’s measuring apparatus, but instead merely teaches a house framing device that does not have application in the electrician field. On the other hand, the electrician’s measuring apparatus disclosed by present claims 1, 2, 5, and 9 comprises a first, second, and third horizontal slot disposed on the substantially flat elongated body at three pre-selected locations directly dependent upon the placement of outlet boxes, counter height outlets,

and standard wall switches, respectively, in accordance with selected standards or codes. Advantageously, the electrician's measuring apparatus called for by applicant's present claims 1, 2, 5, and 9 readily guides the electrician in accurately and levelly positioning outlet boxes, counter height outlets, and standard wall switches, respectively, at precise locations above regular and irregular floors or other surfaces (such as counters) in compliance with applicable requirements set forth by relevant construction standards and codes.

Moreover, the electrician's measuring apparatus required by applicant's present claims 1, 2, 5, and 9 requires a substantially flat elongated body having a length of about 6 feet appointed for determining horizontal placement of the outlets from one another in accordance with a selected outlet to outlet standard or code. This length has particular importance and function in providing for accurate and precise horizontal placement of outlets in relation to one another. The accurate horizontal placement is achieved due to the length of the elongated body as required by applicant's present claims 1, 2, 5, and 9 of about 6 feet, which represents the maximum allowable distance between outlet boxes as set forth in applicable standards. (Applicant's Specification on page 7, lines 9 – 11, and lines 20 – 22). Neither Bennett, Jardine, Plesh, Wheeler nor Gottlieb disclose, alone or in combination, a measuring device that can be utilized for both the vertical and horizontal placement of outlet boxes, counter height outlets, and standard wall switches, respectively, as specified by regulatory standards. Applicant submits that present claim 2 patentably defines over the proposed combination of Bennett, Jardine, Plesh, Wheeler and Gottlieb.

For quite some time the art has struggled to devise an easy to use, integrated electrician's measurement apparatus that readily enables the user to mark and locate the position of outlet

boxes, counter height outlets, and standard wall switches, respectively, having varying sizes and shapes, at a selected distance from a floor or other surface, thereby meeting applicable code requirements. Yet, up until the time of applicant's invention no device capable of providing a user with an integrated measurement apparatus that marks and locates the position of outlet boxes, counter height outlets, and standard wall switches, respectively, at a selected distance from a floor (vertically) and from one another (horizontally) in conformance with applicable code requirements has been proposed by any prior art works, including the proposed combination of Bennett, Jardine, Plesh, Wheeler and Gottlieb. The prior art inventions and their attendant disadvantages are discussed at pages 1 – 3 of the specification.

In contrast to the teachings of the cited references, applicant has surprisingly discovered that combining together a substantially flat elongated body having a length of about 6 feet appointed for determining horizontal placement of the outlets from one another, while at the same time providing a first, second, and third horizontal slot at three specific locations for the placement of outlet boxes, counter height outlets, and standard wall switches, respectively, in accordance with selected standards or codes, as required by applicant's claims 1, 2, 5, and 9 results in an apparatus that increases the overall efficiency of construction projects. Specifically, the electrician's measuring apparatus called for by applicant's present claims 1, 2, 5, and 9 readily guides the electrician so as to enable an accurate, level, vertical positioning of outlet boxes, counter height outlets, and standard wall switches, respectively, at precise locations above regular and irregular floor or other surfaces (such as counters) in compliance with applicable requirements of standards and codes. In addition, the electrician's measuring apparatus called for by applicant's present claims 1, 2, 5, and 9 readily guides the electrician to thereby enable an

accurate, level horizontal positioning of outlet boxes, counter height outlets, and standard wall switches, respectively, at precise locations from one another in compliance with applicable standards and codes. The horizontal placement is achieved due to the length of the elongated body, as required by applicant's present claims 1, 2, 5, and 9 of about 6 feet, which represents the maximum allowable distance between outlet boxes as set forth in applicable standards. (Applicant's Specification on page 7, lines 9 – 11, and lines 20 – 22).

In addition, Gottlieb teaches that it would not be practical to have slots transversely located on a measuring strip having a width of 4 inches, but instead teaches that where the measuring strip has a width of 4 inches side openings or notches (13, and 14) on opposite edges are to be utilized rather than slots. (Gottlieb, column 4, lines 18 – 38, particularly at lines 31 – 38; Shown in Gottlieb, figure 2). Significantly, Gottlieb teaches that when the device has a width of 4 inches it is "not [entirely] practicable to provide transverse slots corresponding to slots (5) and (6)" [of figure 1] and "therefore notches" are instead provided. (Gottlieb, column 4, lines 24 – 38). Inasmuch as applicant's claim 2 includes the slots required by claim 1, the electricians measuring apparatus defined by claim 2 is not taught by Gottlieb and is in fact taught away from.

Accordingly, reconsideration of the rejection of claim 2 under 35 USC §103(a) as being unpatentable over the combination of Bennett, Jardine, Plesh, and Wheeler and further in view of Gottlieb is respectfully requested.

CONCLUSION

In view of the amendments to the claims, and the remarks set forth above, it is submitted that the present application is in allowable condition. Entry of this amendment, reconsideration of the rejection of present claims 1, 2, and 5, and allowance of the application are earnestly solicited.

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